

REMARKS

I. Status of the Claims

No claims are amended in this paper. Claims 18, 20-28, and 30-51 remain pending and under current examination. Claims 18, 20-28, and 30-51 were rejected by the Examiner¹.

II. Rejection of Claims 18, 20-28, and 30-51

The Examiner withdrew the finality of the Office Action mailed December 18, 2008, and maintained the rejection of claims 18, 20-28, and 30-51 under 35 U.S.C. § 103(a) as being unpatentable over Mitsumatsu et al., WO 99/13830 ("Mitsumatsu") in view of Oshima, JP 401009916 ("Oshima") and Sebag et al., WO 98/03155 ("Sebag"). Final Office Action at 2. This rejection was previously presented in the December 18, 2008, Office Action. Applicants respectfully traverse the rejection for at least the following reasons.

The Examiner admitted that Mitsumatsu "does not provide a specific example which concurrently uses stearyl alcohol and behenyl alcohol in the ratio as required by instant claim 18." Final Office Action at 2. However, the Examiner asserted that "Oshima teaches a shampoo containing anionic and/or [amphoteric] surfactant and stearyl alcohol and behenyl alcohol as essential components," and that "[t]he shampoo is ... 'capable of imparting pearl luster to hair.'" Id. at 3. The Examiner also asserted that "[i]t would have been obvious ... to modify the teaching of Mitsumatsu by using stearyl and behenyl alcohols in the weight ratio as motivated by Oshima." Id.

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

The Examiner also alleged that the Declaration under 37 C.F.R. § 1.132 filed on December 1, 2008, does not place the application in allowable condition. Id. at 4. In particular, the Examiner asserted that “[t]he data does not reasonably represent the scope of the present claims, which claim the C18:C22 fatty alcohol ratios of from 0.15 to 20. Moreover, claims 32-34 require the fatty alcohol ratios be greater than 0.19, thus applicant’s data is clearly not commensurate with the scope of these claims.” Id. at 6. Further, the Examiner alleged that, even though Comparative Example 6 of Oshima showed poor performance and could not accomplish the objective of Oshima’s invention, Comparative Example 6 “exhibit[ed] a favorable pearlescence, which is the goal applicant seeks to achieve with the present invention.” Id. at 7. Finally, the Examiner alleged that “at issue is whether the applicant’s declaration ... shows sufficient evidence of unexpected results to overcome the *prima facie* case of obviousness.” Id.

Applicants respectfully disagree with all of the Examiner’s allegations and submit that the Examiner has not established a *prima facie* case of obviousness. The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. M.P.E.P. § 2142.

One rationale “to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art.” M.P.E.P. § 2143.02. It appears the Examiner applied this rationale in rejecting claims 18, 20-28, and 30-51.

However, “prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success.... Obviousness does not require absolute predictability, however, at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness.” M.P.E.P. §§ 2143.02(I) and (II) (emphases added).

Applicants respectfully submit that the Examiner misunderstood the purpose and significance of the December 1, 2008, Declaration. The Declaration was not relied upon to demonstrate unexpected results. Rather, the Declaration was relied upon to demonstrate the unpredictability that exists in the Examiner’s proposed modification of the ratio of stearyl alcohol to behenyl alcohol disclosed by Oshima. As a result of this unpredictability, one of ordinary skill in the art at the time of the present invention would not have had any expectation that a composition prepared by modifying Oshima’s disclosed ratio of stearyl alcohol to behenyl alcohol would possess similar properties as the compositions disclosed by Oshima. That is, one of ordinary skill in the art would not have been able to predict the properties possessed by a composition having a ratio of stearyl alcohol to behenyl alcohol outside the range disclosed by Oshima.

In particular, the Declaration filed on December 1, 2008, compared comparative Composition AA 904, having a ratio of 0.085 (which is outside the range recited in independent claim 18), with inventive Composition AA 905, having a ratio of 0.19 (which is within the range recited in independent claim 18). The viscosity of inventive Composition AA 905 was found to be less temperature dependent than the viscosity of comparative Composition AA 904. Oshima claims a ratio of stearyl alcohol

to behenyl alcohol within a range of 1:1.5 to 1:4.5, which may be also expressed as 0.222 - 0.667. English translation of Oshima, page 3, "Construction of the Invention" paragraph. Both comparative Composition AA 904 and inventive Composition AA 905 had a ratio value that was outside the range disclosed by Oshima. However, as noted above, the viscosity of inventive Composition AA 905 was less temperature dependent than the viscosity of comparative Composition AA 904. Thus, one of ordinary skill in the art could not have predicted the properties, such as the temperature dependence of viscosity, which would result from modifying the ratio of stearyl alcohol to behenyl alcohol disclosed by Oshima. Moreover, one of ordinary skill in the art would not have had a reasonable expectation of success from modifying the ratio of stearyl alcohol to behenyl alcohol disclosed by Oshima.

Accordingly, the Declaration provides objective evidence of unpredictability which undermines the Examiner's allegation of a *prima facie* case of obviousness. Given this unpredictability, it would not have been obvious for one of ordinary skill in the art to have combined Mitsumatsu and Oshima in the manner suggested by the Examiner in an attempt to achieve the present invention.

In addition, Applicants do not necessarily agree with the Examiner's allegation that Comparative Example 6 of Oshima "exhibit[ed] a favorable pearlescence." Final Office Action at 7. Nevertheless, given that Comparative Example 6 showed poor performance and could not accomplish the objective of Oshima's invention, one of ordinary skill would not have considered modifying Oshima's Comparative Example 6 in an attempt to achieve the present invention.

For at least these reasons, the Examiner's proposed combination of Mitsumatsu and Oshima does not disclose or suggest the subject matter of Applicants' independent claim 18. As explained in the Reply to Office Action filed March 18, 2009, Sebag does not overcome the deficiencies of Mitsumatsu and Oshima. This is at least because Sebag does not disclose a composition using stearyl alcohol, behenyl alcohol, or both. Example 1 of Sebag includes stearyl alcohol oxyethylentated with ethylene oxide, and no other Examples of Sebag use any form of stearyl alcohol. Sebag, col. 17, lines 36-60. None of Sebag's Examples include behenyl alcohol, and none include a combination of stearyl and behenyl alcohols.

Independent claim 18 should therefore be allowable over Mitsumatsu, Oshima, and Sebag. Independent claims 47, 49, and 50 differ in scope from claim 18 but recite similar limitations and should be allowable at least for reasons similar to those presented regarding claim 18. Claims 20-28, 30-46, 48, and 51 should also be allowable, at least due to their dependence from claim 18, 47, or 50. Applicants, therefore, respectfully request reconsideration and withdrawal of the rejection.

III. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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